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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/695,501	10/27/2003	Hyewhon Rhim	8111-033-999	8170
20583	7590	02/07/2006	EXAMINER	
JONES DAY 222 EAST 41ST ST NEW YORK, NY 10017			MCINTOSH III, TRAVISS C	
			ART UNIT	PAPER NUMBER
			1623	
DATE MAILED: 02/07/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/695,501

Applicant(s)

RHIM ET AL.

Examiner

Traviss C. McIntosh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 8/1/05
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION***Claim Objections***

Claim 4 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The intended use of the composition has no patentable import on the composition as claimed.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is drawn to a composition comprising “a ginsenoside selected from a group consisting of 20(S)-ginsenoside Rg₃, 20(S)-ginsenoside Rh₂ and mixture of 20(S)-ginsenoside Rg₃ and 20(S)-ginsenoside Rh₂.” It is unclear how “a ginsenoside” can be a mixture, as “a” indicates one ginsenoside. The examiner recommends the following proposed claim amendment to obviate the instant rejection: “A composition for inhibiting glutamate-mediated neurotoxicity comprising a ginsenoside selected from a group consisting of 20(S)-ginsenoside Rg₃ and 20(S)-ginsenoside Rh₂, or a mixture of 20(S)-

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ginsenoside Rg₃ and 20(S)-ginsenoside Rh₂.” Claim 3 should also be amended correlatively.

Claim 1 is indefinite wherein the claims is drawn to a composition comprising a ginsenoside, but does not include anything else. It is noted that compositions should include more than one agent. Applicants should include an additional agent for which there is support founded in the specification, such as a “carrier”, per page 6 of the specification.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4 are rejected under 35 U.S.C. 102(a) as being anticipated by Yun et al. (US 2003/0185910 A1).

Claim 1 is drawn to a composition comprising a ginsenoside selected from a group consisting of 20(S)-ginsenoside Rg₃ and 20(S)-ginsenoside Rh₂, or a mixture of 20(S)-ginsenoside Rg₃ and 20(S)-ginsenoside Rh₂. Claim 2 provides the ginsenoside is 20(S)-ginsenoside Rh₂. Claim 3 provides the ginsenoside is a mixture of 20(S)-

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ginsenoside Rg₃ and 20(S)-ginsenoside Rh₂. Claim 4 does not limit claim 1, as set forth *supra*.

Yun et al. disclose a composition comprising a mixture of ginsenosides Rg₃, Rg₅, and Rh₂, water, and a pH controlling agent (see preparation example 1 on page 7). It is noted that since applicants use open claim language, this composition meets the limitations of applicant's claims. Moreover, it is noted that the intended use of the composition as set forth in the preamble does not impart patentability of the composition over the prior art's composition, as the prior art's composition must have been capable of the same use. See *In re Thorpe*, 227 USPQ 964, 966 (Fed Cir 1965).

Claims 1, 2, and 4 are rejected under 35 U.S.C. 102(a) as being anticipated by Kim et al. ("Inhibitory Effect of Ginsenosides on NMDA Receptor-mediated Signals in Rat Hippocampal Neurons", Biochemical and Biophysical Research Communications, 296, pp. 247-254, 2002).

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

Claims 1, 2, and 4 are drawn to compositions as set forth *supra*.

Kim et al. disclose compositions comprising individual ginsenosides including Rg₃ and Rh₂ (see page 252, right column).

Claims 1, 2, and 4 are rejected under 35 U.S.C. 102(e) as being anticipated by Huang et al. (US 6,888,014 B2).

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Claims 1, 2, and 4 are set forth supra.

Huang et al. disclose compositions comprising 20(S)-ginsenoside Rh₂ (see example 3 in column 13).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Traviss C. McIntosh whose telephone number is 571-272-0657. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shaojia Jiang can be reached on 571-272-0627. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Traviss C. McIntosh III
January 5, 2006

Shaojia A. Jiang
Supervisory Patent Examiner
Art Unit 1623



A handwritten signature in black ink, appearing to read 'S. Jiang', followed by the date '1/6/06' written vertically.